

Remarks

Applicants have canceled claims 2-18, 20-21 and 25-29 without prejudice or disclaimer and added new claims 31-107. Applicants reserve the right to pursue the subject matter of the canceled claims in related applications. The amendments are fully supported by the specification and claims as originally filed, and thus no new matter has been added.

Originally filed claims 1, 19, 22-24 and 30, and new claims 31-107 will be pending upon entry of these amendments.

I. Amendment of the Claims

Claims 2-18, 20-21 and 25-29 have been canceled in favor of new claims 31-107 in order to cover additional embodiments of the subject matter of the provisionally elected group. Applicants submit that the subject matter of new claims 31-107 falls within the scope of Group III, as defined by the Examiner in the Office Action mailed September 27, 2002 (Paper No. 5). New claims 31-107 find support in the claims as originally filed and throughout the specification. Specifically, support for new claims 31-107 is found, for example, at page 3, lines 26-28; the paragraph spanning pages 17-18; page 18, lines 29-34; and page 23, line 25, through page 24, line 21.

Accordingly, no new matter has been added by way of amendment, and entry of the above amendment is therefore respectfully solicited.

II. The Restriction Requirement

Pursuant to Paper No. 5, mailed September 27, 2002, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I-VI. The Examiner contends that the inventions are distinct, each from the other.

In response, Applicants provisionally elect, *with traverse*, the subject matter of Group III, represented by claim 22 and new claims 31-107, drawn to antibodies specific for ICE-LAP 3 and 4, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. Applicants point out that original claims 2-18, 20-21 and 25-29 have been canceled without prejudice or disclaimer, and that new claims 31-107 are directed to subject matter falling within the ambit of Group III as cast by the Examiner.

With respect to the Examiner's division of the invention into nine groups and the reasons stated therefor, Applicants respectfully disagree and traverse. Even assuming, *arguendo*, that Groups I-VI represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of all groups would entail a "serious burden." See M.P.E.P. § 803. In the present situation, no such showing has been made. Although the Examiner has argued that Groups I-VI are separately classified, Applicants nonetheless submit that a search of the polypeptide claims would also provide useful information for the claims of the other groups. For example, in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein and antibodies to the protein. Thus, since the searches for proteins, nucleic acids encoding such proteins, and antibodies to such proteins commonly overlap, the combined search and examination of such compositions would not entail a serious burden.

Accordingly, in view of M.P.E.P. § 803, the claims of all of Groups I-VI should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn, and that the instant claims be examined in one application.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R.

§ 1.144.

Conclusion

Entry of the above amendment is respectfully solicited. In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

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Respectfully submitted,

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